

REMARKS/ARGUMENTS

1) Claim 18 stands rejected under 35 U.S.C. 102(e) as being anticipated by Jackson et al PN 4,727,500. Applicant respectfully traverses this rejection as set forth below:

In order that the rejection of Claim 18 be sustainable (under 35 U.S.C. 102(e)), it is fundamental that “each and every element as set forth in the claim be found, either expressly or inherently described, in a single prior art reference.” Verdegall Bros. v. Union Oil Co. of California, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). See also, Richardson v. Suzuki Motor Co., 9 USPQ2d 1913, 1920 (Fed. Cir. 1989), where the court states, “The identical invention must be shown in as complete detail as is contained in the ... claim”.

Furthermore, “all words in a claim must be considered in judging the patentability of that claim against the prior art.” In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

Claim 18, as amended, requires and positively recites, an apparatus, comprising: “means for sampling a temperature associated with the operation of said apparatus”, “means, responsive to said sampled temperature, for predicting **future temperature** associated with the operation of said apparatus” and “means for using said prediction for automatic temperature control within said apparatus”.

In contrast, Jackson discloses a technique in which temperature is sampled at the probe tip 13a at subsequent sample times and a final temperature is computed based upon the independent samplings. More specifically, Jackson discloses the following:

During the 25 second data collection period the circuit checks for a temperature drop every second, but stores temperature data only every 5 seconds. The stored temperature data for the starting time T0 and subsequent sample time T5, T10, T15, T20 and T25 is used **to compute a final probe temperature**,

corresponding to the patient's temperature (col. 3, lines 66 – col. 4, line 4).

After the elapse of 25 seconds, the final temperature TF is predicted and displayed through the use of one of the three prediction algorithms shown in FIGS. 4, 5 and 6. (col. 4, lines 5-8)

Thus, Jackson discloses use of multiple samples of temperature taken over time to predict the EXISTING temperature of a patient. Jackson does not teach or suggest a technique for “predicting” FUTURE temperature of a patient. As such, Jackson fails to teach or suggest, “means, responsive to said sampled temperature, for predicting **FUTURE temperature** associated with the operation of said apparatus”, as required by Claim 18. Accordingly, the Examiner’s rejection has not complied with case law such that, “each and every element as set forth in the claim be found, either expressly or inherently described, in a single prior art reference.” The 35 U.S.C. 102(e) rejection of Claim 18 over Jackson is erroneous and should be withdrawn.

2) Claims 17-18, 21, 74-79 and 122 stand rejected under 35 U.S.C. 102(e) as being anticipated by Dischler et al. PN 6,311,287. Applicant respectfully traverses this rejection as set forth below:

Applicant submits herein his declaration under 37 C.F.R. 1.131 to antedate the Dischler reference by showing conception of his invention on a date prior to October 11, 1994 and diligence in reducing his invention to practice from a date prior to October 11, 1994, which is the first effective date of cited U.S. Patent to Dischler et al. (6,311,287), until the invention was actually reduced to practice on a date no later than December 15, 1994. Accordingly, the rejection of 17-18, 21, 74-79 and 122 stand rejected under 35 U.S.C. 102(e) as being anticipated by Dischler et al. PN 6,311,287, is now moot.

3) Claims 19-20 and 23 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Dischler et al PN 6,311,287 in view of Chen et al PN 5,422,806. Applicant respectfully traverses this rejection as set forth below:

Applicant submits herein his declaration under 37 C.F.R. 1.131 to antedate the Dischler reference by showing conception of his invention on a date prior to October 11, 1994 and diligence in reducing his invention to practice from a date prior to October 11, 1994, which is the first effective date of cited U.S. Patent to Dischler et al. (6,311,287), until the invention was actually reduced to practice on a date no later than December 15, 1994. Accordingly, the rejection of Claims 19-20 and 23 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Dischler et al PN 6,311,287 in view of Chen et al PN 5,422,806, is now moot.

4) Claims 83-88 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Dischler et al PN 6,311,287 in view of Kikinis PN 5,502,838. Applicant respectfully traverses this rejection as set forth below:

Applicant submits herein his declaration under 37 C.F.R. 1.131 to antedate the Dischler reference by showing conception of his invention on a date prior to October 11, 1994 and diligence in reducing his invention to practice from a date prior to October 11, 1994, which is the first effective date of cited U.S. Patent to Dischler et al. (6,311,287), until the invention was actually reduced to practice on a date no later than December 15, 1994. Accordingly, the rejection of Claims 83-88 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Dischler et al PN 6,311,287 in view of Kikinis PN 5,502,838, is now moot.

5) Claims 88-91 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Dischler et al. PN 6,311,287. Applicant respectfully traverses this rejection as set forth below:

Applicant submits herein his declaration under 37 C.F.R. 1.131 to antedate the Dischler reference by showing conception of his invention on a date prior to October 11, 1994 and diligence in reducing his invention to practice from a date prior to October 11, 1994, which is the first effective date of cited U.S. Patent to Dischler et al. (6,311,287), until the invention was actually reduced to practice on a date no later than December 15, 1994. Accordingly, the rejection of Claims 88-91 as being unpatentable over 35 U.S.C. 103(a), is now moot.

6) Claims 104-106 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Dischler et al PN 6,311,287 in view of Hollowell, II et al PN 5,590,061. Applicant respectfully traverses this rejection as set forth below:

Applicant submits herein his declaration under 37 C.F.R. 1.131 to antedate the Dischler reference by showing conception of his invention on a date prior to October 11, 1994 and diligence in reducing his invention to practice from a date prior to October 11, 1994, which is the first effective date of cited U.S. Patent to Dischler et al. (6,311,287), until the invention was actually reduced to practice on a date no later than December 15, 1994. Accordingly, the rejection of Claims 104-106 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Dischler et al PN 6,311,287 in view of Hollowell, II et al PN 5,590,061, is now moot.

7) Claims 110-112, 114-115, 117-118, 120-121 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Dischler et al PN 6,311,287 in view of Kikinis as applied to claims 83-88 above and further in view of Gephardt et al PN 5,493,684. Applicant respectfully traverses this rejection as set forth below:

Applicant submits herein his declaration under 37 C.F.R. 1.131 to antedate the Dischler reference by showing conception of his invention on a date prior to October 11, 1994 and diligence in reducing his invention to practice from a date prior to October 11, 1994, which is the first

effective date of cited U.S. Patent to Dischler et al. (6,311,287), until the invention was actually reduced to practice on a date no later than December 15, 1994. Accordingly, the rejection of Claims 110-112, 114-115, 117-118, 120-121 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Dischler et al PN 6,311,287 in view of Kikinis as applied to claims 83-88 above and further in view of Gephardt et al PN 5,493,684, is now moot.

Claims 17-21, 23 and 74-122 stand allowable over the cited art. New Claims 123-136 have been added and are similarly allowable over the cited art. Applicant respectfully requests allowance of the application as the earliest possible date.

Respectfully submitted,



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